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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,126	04/11/2000	Fred R. Huege	0438CG-54	4486

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EXAMINER
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BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

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DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/547,126

Applicant(s)

HUEGE ET AL.

Examiner

Kevin M Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendments to the specification and claims 1 – 4, 8 – 15 and 19 - 36, filed on January 10, 2003, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Examiner's Comments***

3. The Examiner notes that the change in the headings of the rejections (Paragraphs 4 and 5, below) were made to more clearly note that applicants' admissions were relied upon for the definition of "hydrated lime" and for the fact that hydrated lime is a form of alkaline earth metal hydroxide. No change in the basis of the rejections was made.

### ***Claim Rejections - 35 USC § 103***

4. Claims 1, 3, 4 – 12 and 14 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over George et al. ('573) in view of Anthenien et al. ('895) and applicants' admissions.

Regarding claims 1 and 12, George et al. disclose an asphalt roofing structure, comprising: a substrate form selected from the group consisting of roll roofing and shingle substrates (*col. 1, lines 10 – 11*), an asphalt composition applied to the

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substrate form, the asphalt composition comprising a mixture of an asphaltic base and filler (*col. 2, lines 41 – 44; col. 2, line 65 bridging col. 3, line 7; and col. 5, lines 5 - 45*).

George et al. fail to disclose the asphalt composition including “an amount of hydrated lime sufficient to improve tear strength and durability properties of the asphalt structure, the hydrated lime comprising an alkaline earth metal hydroxide selected from the group consisting of  $\text{Ca(OH)}_2$ ,  $\text{Mg(OH)}_2$ , and  $\text{Ca(OH)}_2\text{:Mg(OH)}_2$ ” (*claim 1*), nor an asphalt composition including water and an alkaline earth metal hydroxide formed from reacting an alkaline earth metal oxide with said water (*claim 12*).

However, Anthenien et al. teach an improved asphalt emulsion composition for use in roofs (*col. 1, lines 25 – 26*) comprising hydrated lime (*col. 2, line 21*), water (*i.e. an “emulsion” is deemed to necessarily possesses water*), an asphalt and a filler (*col. 2, lines 3 – 6 and claims 4 and 5*).

Anthenien et al. further disclose that the improved asphaltic composition has good flowability (*“the mixture seeped into the cracks ...”, col. 2, lines 12 – 13*), is very durable, water resistant and has improved flexibility (*col. 2, lines 31 – 33*).

Since George et al. disclose that the asphalt used in the roll roofing or shingle must saturate the substrate form “to the greatest possible extent with a “saturant” asphalt (*George et al., col. 5, lines 9 – 13*), it would therefore have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to modify the device of George et al. to use the asphalt composition taught by Anthenien et al. (*i.e. an asphalt composition comprising hydrated lime*), since it possesses good flowability and will lead to good durability, water resistance and improved flexibility.

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Regarding the limitation “the hydrated lime comprising an alkaline earth metal hydroxide selected from the group consisting of  $\text{Ca}(\text{OH})_2$ ,  $\text{Mg}(\text{OH})_2$ , and  $\text{Ca}(\text{OH})_2:\text{Mg}(\text{OH})_2$ ”, the examiner deems that hydrated lime is necessarily an alkaline earth metal hydroxide selected from the group consisting of  $\text{Ca}(\text{OH})_2$ ,  $\text{Mg}(\text{OH})_2$ , and  $\text{Ca}(\text{OH})_2:\text{Mg}(\text{OH})_2$ , since applicants’ admit that the term “hydrated lime” is known to refer to such compositions (*see applicants’ specification, page 8, lines 5 - 6*).

Regarding the limitation “sufficient to improve tear strength and durability”, this limitation is a functional limitation and is not further limiting in so far as the structure of the product is concerned. As defined in the MPEP, “[a] functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)” – MPEP § 2173.05(g). However, the examiner notes that “where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an ***inherent characteristic of the prior art***, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on” (emphasis added) - MPEP § 2183.

In the instant case, the above functional limitation is deemed to be necessarily present in prior art since the prior art is substantially identical in composition and/or

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structure. The examiner's sound basis for this assertion is that the prior art discloses adding a similar amount of hydrated lime as disclosed by applicants (*see rejection of claims 3 and 4, below*).

Regarding the limitations "heated" (*claims 1 and 12*) and "the hydrated lime being formed by the addition ... reacting with water in the filler" (*claim 12*), these limitations are product-by-process limitations and are not further limiting in so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP § 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show an ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

In the instant case, whether the water comes from the filler, other ingredients or is added separately is not deemed to change the fact that the alkaline earth metal oxide will react with it to form an alkaline earth metal hydroxide (i.e. "hydrated lime"). The prior art product disclose adding hydrated lime (i.e. the alkaline earth metal hydroxide) directly and there is no evidence of record that adding hydrated lime directly versus hydrating the lime *in-situ* would result in a patentability distinct product.

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Regarding claims 3, 4, 14 and 15, Anthenien et al. disclose adding an amount of alkaline earth metal hydroxide meeting applicants' claimed limitations (1.5 – 5.7% hydrated lime) (*col. 2, lines 19 – 23 and claims 3 - 5*). Furthermore, it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the amount of hydrated lime added through routine experimentation in the absence of a showing of criticality in the claimed percentage, especially given the teachings in Anthenien et al. regarding acceptable amounts of hydrated lime to be added for improving the moisture resistance and flexibility of an asphalt composition. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Regarding claims 5 – 7 and 16 – 18, applicants admit that the claimed fillers are old in the art of fillers added to asphalt compositions for use in shingles and roll roofing (*page 3, line 26 bridging page 4, line 19*) and that the appropriate choice of filler depends on the cost, compatibility with the asphalt and aesthetic quality of the shingles. It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of George et al. in view of Anthenien et al. to use fillers meeting applicants' claimed limitations as admitted by applicants as known fillers used in shingles and roll roofing, depending on the cost, compatibility with the asphalt and desired aesthetics.

Regarding claims 8 – 10, 19 and 20, these limitations are product-by-process limitations and are not further limiting in so far as the structure of the article is concerned for the reasons cited above.

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Regarding claims 11 and 21, Anthenien et al. disclose adding an amount of asphalt meeting applicants' claimed limitations (*up to 33% asphalt - col. 2, lines 19 – 23 and claims 3 - 5*). Furthermore, it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the asphalt amount through routine experimentation in the absence of a showing of criticality in the claimed asphalt amount, given that the asphalt must adequately bind the filler while providing both a water impermeable layer as well as providing suitable adhesion for granules on the outer most surface (*George et al., Figures*).

5. Claims 1, 3, 4 – 12 and 14 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over George et al. ('573) in view of Karácsonyi née Éva Spindler et al. [hereafter this patent will be referred to as "Karácsonyi et al"] ('410) and applicants' admissions.

Regarding claims 1 and 12, George et al. is relied upon in an identical manner as described above.

George et al. fail to disclose the asphalt composition including "an amount of hydrated lime sufficient to improve tear strength and durability properties of the asphalt structure, the hydrated lime comprising an alkaline earth metal hydroxide selected from the group consisting of  $\text{Ca(OH)}_2$ ,  $\text{Mg(OH)}_2$ , and  $\text{Ca(OH)}_2\text{:Mg(OH)}_2$ " (*claim 1*), nor an asphalt composition including water and an alkaline earth metal hydroxide formed from reacting an alkaline earth metal oxide with said water (*claim 12*).



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However, Karácsonyi et al. teach an aqueous asphalt composition for use in roofs (*Title and col. 1, lines 13 - 16*) which comprises an alkaline earth metal hydroxide, an asphalt and a filler (*col. 1, line 60 bridging col. 2, line 43; Examples; and claims 1 and 5*).

Further, Karácsonyi et al. disclose that the improved asphaltic composition has good insulating and bonding properties, as well as excellent water resistance (*col. 2, line 68 bridging col. 3, line 7 and col. 4, lines 43 - 44*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of George et al. to use the asphalt composition taught by Karácsonyi et al. since it leads to good insulating and bonding properties, as well as excellent water resistance.

Regarding the limitation "the hydrated lime comprising an alkaline earth metal hydroxide selected from the group consisting of  $\text{Ca(OH)}_2$ ,  $\text{Mg(OH)}_2$ , and  $\text{Ca(OH)}_2\text{:Mg(OH)}_2$ ", the examiner deems that hydrated lime is necessarily an alkaline earth metal hydroxide selected from the group consisting of  $\text{Ca(OH)}_2$ ,  $\text{Mg(OH)}_2$ , and  $\text{Ca(OH)}_2\text{:Mg(OH)}_2$ , since applicants' admit that the term "hydrated lime" is known to refer to such compositions (*see applicants' specification, page 8, lines 5 - 6*). See also Karácsonyi et al. Examples 1 and 4, which disclose adding  $\text{Ca(OH)}_2$ ,  $\text{Mg(OH)}_2$ , and "hydrated lime" (*col. 3, lines 20 - 21 and 33 - 35 and col. 4, lines 14 - 15*).

Regarding the limitation "sufficient to improve tear strength and durability", this limitation is a functional limitation and is not further limiting in so far as the structure of the product is concerned. In the instant case, the above functional limitation is deemed

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to be necessarily present in prior art since the prior art is substantially identical in composition and/or structure. The examiner's sound basis for this assertion is that the prior art discloses adding a similar amount of hydrated lime as disclosed by applicants (*see rejection of claims 3 and 4, below*).

Regarding the limitations "heated" (*claims 1 and 12*) and "the hydrated lime being formed by the addition ... reacting with water in the filler" (*claim 12*), these limitations are product-by-process limitations and are not further limiting in so far as the structure of the product is concerned. In the instant case, whether the water comes from the filler, other ingredients or is added separately is not deemed to change the fact that the alkaline earth metal oxide will react with it to form an alkaline earth metal hydroxide (i.e. "hydrated lime"). The prior art product disclose adding hydrated lime (i.e. the alkaline earth metal hydroxide) directly and there is no evidence of record that adding hydrated lime directly versus hydrating the lime *in-situ* would result in a patentability distinct product.

Regarding claims 2 and 13, Karácsonyi et al. disclose alkaline earth metal hydroxides meeting applicants' claimed limitations (*col. 2, lines 24 – 30*).

Regarding claims 3, 4, 14 and 15, it has been held that where claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily on inherently possess characteristics of claimed products where the rejection is based on inherency under 35

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USC 102 or on *prima facie* obviousness under 35 USC 103, jointly or alternatively. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prime facie* case can be rebutted by **evidence** showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

In the instant case, the disclosed examples possess a substantially identical composition as applicants' claimed composition (asphalt + metal hydroxide + filler) and would appear to necessarily result in a residual alkaline earth metal hydroxide amount meeting applicants' claimed limitations (*especially example 2*). Furthermore, even should the disclosed examples not possess weight percents meeting applicants' claimed limitations, it would have still have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the amount of hydrated alkaline metal hydroxide through routine experimentation in the absence of a showing of criticality in the claimed amount of hydrated alkaline metal hydroxide, especially given the disclosed ratio of aluminum salt and metal hydroxide (*claim 5*) and the amount of aluminum hydroxide desired (*col. 2, lines 5 – 15 and Examples*).

Regarding claims 5, 7, 16 and 18, applicants admit that the claimed fillers are old in the art of fillers added to asphalt compositions for use in shingles and roll roofing

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(page 3, line 26 bridging page 4, line 19) and that the appropriate choice of filler depends on the cost, compatibility with the asphalt and aesthetic quality of the shingles. It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of George et al. in view of Karácsonyi et al. to use fillers meeting applicants' claimed limitations as admitted by applicants as known fillers used in shingles and roll roofing, depending on the cost, compatibility with the asphalt and desired aesthetics.

Regarding claims 6 and 17, Karácsonyi et al. teach adding fillers meeting applicants' claimed limitations (*col. 4, line 50, where limestone is  $\text{CaCO}_3$ , as admitted by applicants on page 3, line 29*).

Regarding claims 8 – 10, 19 and 20, these limitations are product-by-process limitations and are not further limiting in so far as the structure of the article is concerned for the reasons cited above.

Regarding claims 11 and 21, Karácsonyi et al. disclose adding asphalt amounts meeting applicants' claimed limitations (*col. 2, lines 1 – 2 and lines 37 - 43*).

Furthermore, it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the asphalt amount through routine experimentation in the absence of a showing of criticality in the claimed asphalt amount, given that the asphalt must adequately bind the filler while providing both a water impermeable layer as well as providing suitable adhesion for granules on the outer most surface (*George et al., Figures*).

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6. Claims 1, 3, 8 – 10, 12, 14, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over George et al. ('573) in view of either Little et al. ('558) or Little et al. (WO '620). Since both Little et al. references disclose identical subject matter, the examiner will cite page + line numbers only in the WO '620 reference to avoid confusion. Appropriate sections of US '558 have also been underlined for applicants convenience.

Regarding claims 1 and 12, George et al. is relied upon in an identical manner as described above.

George et al. fail to disclose the asphalt composition including "an amount of hydrated lime sufficient to improve tear strength and durability properties of the asphalt structure, the hydrated lime comprising an alkaline earth metal hydroxide selected from the group consisting of  $\text{Ca}(\text{OH})_2$ ,  $\text{Mg}(\text{OH})_2$ , and  $\text{Ca}(\text{OH})_2:\text{Mg}(\text{OH})_2$ " (*claim 1*), nor an asphalt composition including water and an alkaline earth metal hydroxide formed from reacting an alkaline earth metal oxide with said water (*claim 12*).

However, Little et al. teach an asphalt composition comprising hydrated lime comprising an alkaline earth metal hydroxide (*page 3, lines 17 – 25*) which possesses good anti-stripping properties, moisture resistance, inhibited age hardening and improved toughness (*page 2, lines 15 – 24*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of George et al. to use the asphalt composition taught by Little et al. since it leads to good anti-stripping properties, moisture resistance, inhibited age hardening and improved toughness.

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Regarding the limitation “sufficient to improve tear strength and durability”, this limitation is a functional limitation and is not further limiting in so far as the structure of the product is concerned. In the instant case, the above functional limitation is deemed to be necessarily present in prior art since the prior art is substantially identical in composition and/or structure. The examiner’s sound basis for this assertion is that the prior art discloses adding a similar amount of hydrated lime as disclosed by applicants (*see rejection of claims 3 and 4, below*).

Regarding the limitations “heated” (*claims 1 and 12*) and “the hydrated lime being formed by the addition ... reacting with water in the filler” (*claim 12*), these limitations are product-by-process limitations and are not further limiting in so far as the structure of the product is concerned. In the instant case, whether the water comes from the filler, other ingredients or is added separately is not deemed to change the fact that the alkaline earth metal oxide will react with it to form an alkaline earth metal hydroxide (i.e. “hydrated lime”). The prior art product disclose adding hydrated lime (i.e. the alkaline earth metal hydroxide) directly and there is no evidence of record that adding hydrated lime directly versus hydrating the lime *in-situ* would result in a patentability distinct product.

Regarding claims 2 and 13, Little et al. disclose alkaline earth metal hydroxides meeting applicants’ claimed limitations (*page 3, lines 20 – 25*).

Regarding claims 3 and 14, Little et al. disclose amounts of alkaline earth metal hydroxides meeting applicants’ claimed limitations (*page 2, lines 3 – 6*). The examiner

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notes that "about 10% to 20%" reads on the claimed range of "between 1 – 10%" since "about 10%" includes values slightly below 10%.

Regarding claims 8 – 10, 19 and 20, these limitations are product-by-process limitations and are not further limiting in so far as the structure of the article is concerned for the reasons cited above.

7. Claims 5 – 7 and 16 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over George et al. in view of either Little et al. reference as applied above, and further in view of applicants' admissions.

Regarding claims 5 – 7 and 16 – 18, George et al. in view of either Little et al. reference disclose the claimed invention as described above.

Neither Little et al. reference disclose adding fillers meeting applicants' claimed limitations.

However, applicants admit that the claimed fillers are old in the art of fillers added to asphalt compositions for use in shingles and roll roofing (*page 3, line 26 bridging page 4, line 19*) and that the appropriate choice of filler depends on the cost, compatibility with the asphalt and aesthetic quality of the shingles.

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of George et al. in view of either Little et al. reference to use fillers meeting applicants' claimed limitations as admitted by applicants as known fillers used in shingles and roll roofing, depending on the cost, compatibility with the asphalt and desired aesthetics.

***Response to Arguments***

**8. The rejection of claims 1 - 21 under 35 U.S.C § 103(a) – George et al. in view of Anthenien et al. and applicants' admissions**

Applicant(s) argue(s) that the Anthenien et al. reference teaches away from the claimed invention since the Anthenien et al. reference does not use a "heated" asphalt and also contains a polymeric material (i.e. acrylic emulsion). The examiner respectfully disagrees.

The limitation "heated" is a product-by-process limitation and there is no evidence of record that a product made from a different process (i.e. a room temperature mixture) would result in a patentably distinct final product. Furthermore, the Examiner notes that applicants' present claims are open to the presence of additional elements, such as the Anthenien et al. acrylic emulsion.

**9. The rejection of claims 1 - 21 under 35 U.S.C § 103(a) – George et al. in view of Karácsanyi née Éva Spindler et al. (i.e. the "Karácsanyi et al." reference) and applicants' admissions**

**The rejection of claims 1 - 3, 8 – 10, 12 - 14, 19 and 20 under 35 U.S.C § 103(a) – George et al. in view of either Little et al. reference**

Applicant(s) argue(s) that neither Karácsanyi et al. nor Little et al. are analogous art to applicants' and George et al.'s disclosed roofing applications. The examiner respectfully disagrees.



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George et al. is directed to an asphalt roofing system, including asphalt shingles and roll roofing, wherein the asphalt used provides waterproofing and good adhesion to the substrate web/granules used in roofing shingles/roll roofing (*col. 2, lines 25 – 38 and col. 5, lines 5 - 32*). Karácsonyi et al. is directed to an asphalt composition for use in the construction industry, including applications involving “roof plates or covering slabs with carrier materials” (*col. 1, lines 7 – 17*), for improved water-insulating and bonding (*col. 2, line 56 bridging col. 3, line 7*). Since both George et al. and Karácsonyi et al. are directed to roofing applications requiring the same principal features (i.e. waterproofing and good adhesion), the Examiner deems that Karácsonyi et al. is analogous art.

Little et al. is directed to asphalt compositions used primarily in paving, wherein the addition of hydrated lime results in improved moisture resistance, improved bonding and the inhibition of age hardening (*page 1, lines 16 – 18 and page 2, lines 14 – 24*). While Little et al. does not explicitly disclose using the asphalt composition in roofing applications, a similar problem is solved in the Little et al. reference (i.e. improved bonding and moisture resistance). Furthermore, the Examiner deems that one of ordinary skill in the art would readily recognize that asphalt compositions are used in both roofing applications and paving applications (*e.g. see Karácsonyi et al.: col. 1, lines 7 – 30 and col. 3, lines 8 – 14*) and, therefore, the asphaltic paving compositions of Little et al. are considered analogous to the asphaltic roofing compositions used by the George et al. invention.

**Conclusion**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB  
March 7, 2003



Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700